Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte KOJI ZETTSU, KAZUHIRO MINAMI and HAJIME TSUCHITANI

Appeal No. 2005-0365
Application No. 09/625,298

ON BRIEF

Before RUGGIERO, GROSS, and MACDONALD, ***Administrative Patent Judges***.

MACDONALD, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-14.

Invention

Appellants' invention relates to a Hypertext Markup Language (HTML) system and method for permitting alteration of the contents or layout to be embedded into a page template without having to edit the HTML file or modify the server program such as CGI. Appellants' specification at page 2, lines 15-18.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A display information fixing method to be executed on a display information fixing apparatus for transmitting page information to an information terminal having a display screen and an input unit, comprising the steps of:

(a) analyzing a page template specified by a display information acquisition request from said information terminal,

(b) acquiring formatter specifying information and display attribute information from said page template,

(c) acquiring a formatter on the basis of said formatter specifying information,

(d) processing contents to be incorporated into said page template on the basis of said display attribute, to generate page information to be displayed on the display apparatus of said information terminal, wherein said page information is used to generate an HTML page; and,

(e) permitting alteration of said contents to be incorporated into said page template without requiring editing of an HTML file.

References

The references relied on by the Examiner are as follows:

Roewer	5,734,915	Mar. 31, 1998
Rasansky et al. (Rasansky)	5,960,406	Sep. 28, 1999

Rejections At Issue

Claims 1-14 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Roewer and Rasansky.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.[1]

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated ***infra***, we reverse the Examiner's rejection of claims 1-14 under 35 U.S.C. § 103.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellants have indicated that for purposes of this appeal, the claims stand or fall together as one group. See page 5 of the brief. Appellants have fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) states:

> *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of

[1] Appellants filed an appeal brief on August 8, 2003. Appellants filed a reply brief on March 15, 2004. The Examiner mailed an Examiner's Answer on January 14, 2004.

> that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in one group, and we will treat claim 1 as a representative claim of that group. If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. ***In re McDaniel***, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). ***See also In re Watts***, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

Whether the Rejection of Claims 1-14 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-14. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a ***prima facie*** case of obviousness. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). ***See also In re Piasecki***, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the

prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. ***See also Piasecki***, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." ***In re Lee***, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue at page 6 of the brief that nothing in Roewer teaches a formatter as claimed by Appellants. The Examiner responds at page 6 of the answer by pointing to Roewer at column 19, lines 15-21. We have reviewed this section of the reference as well as column 8, lines 15-22, which were cited in the rejection. We find nothing in either column that teaches acquiring a formatter. We note that a "formatter" is a specific type of program to be executed (Appellants' specification at page 29,

lines 17-18). At best the cited sections of Roewer teach formatting information. We find Appellants' argument persuasive for these reasons.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 1-14.

REVERSED

JOSEPH F. RUGGIERO)
Administrative Patent Judge)
)
ANITA PELLMAN GROSS) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
ALLEN R. MACDONALD)
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